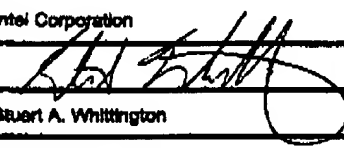
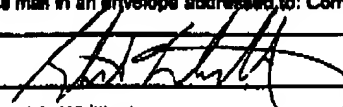


PTO/SB/21 (09-04)
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| TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small> | Application Number | 09386,607 | RECEIVED CENTRAL FAX CENTER NOV 28 2005 |
| | Filing Date | 8/30/1999 | |
| | First Named Inventor | William M. Perrott | |
| | Art Unit | 2137 | |
| | Examiner Name | Callahan, P. | |
| Total Number of Pages in This Submission | 15 | Attorney Docket Number | 42890.P12218 |

| ENCLOSURES (Check all that apply) | | |
|---|--|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.62 or 1.63 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): |
| Remarks _____ | | |
| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | |
| Firm Name | Intel Corporation | |
| Signature |  | |
| Printed name | Stuart A. Whittington | |
| Date | November 28, 2005 | Reg. No. 45,215 |

| CERTIFICATE OF TRANSMISSION/MAILING | |
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| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | |
| Signature |  |
| Typed or printed name | Stuart A. Whittington |
| Date | November 28, 2005 |

This collection of information is required by 37 CFR 1.6. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4618).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

| | | | |
|--------------------------------|--|-------------|---------------|
| TOTAL AMOUNT OF PAYMENT | | (\$) | 500.00 |
|--------------------------------|--|-------------|---------------|

| | |
|--------------------------|--------------------|
| Complete If Known | |
| Application Number | 09/385,807 |
| Filing Date | 8/30/1999 |
| First Named Inventor | William M. Parrott |
| Examiner Name | Celahan, P. |
| Art Unit | 2137 |
| Attorney Docket No. | 42390.P12216 |

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 50-0221 Deposit Account Name: _____

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2036.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

Total Claims **Extra Claims** **Fee (\$)** **Fees Paid (\$)**

- 20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fees Paid (\$)**

- 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fees Paid (\$)**

- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification. \$130 fee (no small entity discount) **Fees Paid (\$)**

Other (e.g., late filing surcharge): Appeal Brief - Fee Code: 1402 **500**

SUBMITTED BY

| | | |
|---|--------------------------|------------------------|
| Signature | Registration No. 45, 215 | Telephone 480.715.3895 |
| Name (Print/Type) Stuart A. Whittington | (Attorney/Agent) | Date November 28, 2005 |

This collection of information is required by 37 CFR 1.13b. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 38 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1480, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1480, Alexandria, VA 22313-1480.

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Date of Transmission: Nov 28, 2005

By: 

Stuart Whittington

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of William M. Parrott

Atty. Docket No: (Old: 008193-20001)
(New: 42390.P12216)

Appln. No.: 09/385,607

Group Art Unit: 2137

Filed: August 30, 1999

Examiner: Callahan, Paul E.

Title: SECURE TRANSACTION MODEM STORING UNIQUE INDICIA

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Pursuant to Appellant's Notice of Appeal filed on September 26, 2005, Appellant presents this Brief in appeal of the Final Rejection dated March 24, 2005.

I. REAL PARTY IN INTEREST.

Intel Corporation is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES.

There are no related appeals or interferences before the Board of Patent Appeals and Interferences or related judicial proceedings known to Appellant, the Appellant's legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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APPELLANT'S BRIEF
U.S. Appln. No. 09/385,607

III. STATUS OF CLAIMS.

Claims 1-27 have been pending in the application. Claims 22-27 have been cancelled leaving claims 1-21 as the only pending claims remaining. Claims 1-21 stand finally rejected and are the claims subject to this appeal, which are reproduced in Appendix A.

IV. STATUS OF AMENDMENTS.

Appellant submitted an Amendment on June 23, 2005 subsequent to the Final Office Action of March 24, 2005. The Amendment only presented two proposed drawing changes to address specific drawing objections in the Final Office Action. No amendments to the claims were presented. In the Advisory Action dated August 5, 2005, it was indicated that Appellant's amendment would not be entered prior to Appeal because it raised new issues requiring further consideration and raised the issue of new matter. The Board is respectfully requested to instruct that this amendment be entered as no new issues or new matter have been presented as Appellant has only attempted to comply with the specific requests made in the Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER.

The inventive embodiments generally relate to secure online transactions conducted with a modem. (Specification pg. 1, ll. 12-13). The integrity of online transactions have been the subject of much concern. There has been a growing need to authenticate or otherwise validate the identify of participates in online commerce transactions. (Spec. pg. 1, ll. 19-20). Embodiments of the present invention relate to a modem with integral identification indicia that

APPELLANT'S BRIEF
U.S. Appl. No. 09/385,607

can be accessed by communications software such as the operation software of the modem and transmitted to a host to validate the identity of a user. (Spec. pg. 2, ll. 21-23).

Referring to Fig. 2, a modem 40 may include a microprocessor 26 to control operations and manage communication with a host computer. Modem 42 may also include a memory (e.g., flash ROM 42) to provide storage space for storing indicia 44 of an identification of a user. (Spec. pg. 12, ll. 13-20). The modem software is modified to transmit the identifying indicia, preferably in encrypted form, when required to validate a transaction. By providing identifying indicia within memory that can only be altered by overwriting the modem program, it becomes difficult to counterfeit the identifying indicia or the secure modem. (Spec. pg. 13, ll. 4-11).

In one embodiment, the identifying indicia may be stored into modem 40 after the manufacturing process and stored by, for example, a financial institution issuing the modem or that will process the financial transactions. In a generalized embodiment, a compressed image or other authentication indicia might be stored within a non-volatile memory. For example, an image of a credit card including a credit card number and a signature could be stored in the EEPROM of the modem (Spec. pg. 7, ll. 13-17).

In the example of Fig. 2, the identifying indicia may be stored in memory space 44 and might be an image of a user's credit card, complete with signature and preferably the image of the credit card holder stored in a widely accepted data format such as a .pdf format. (Spec. pg. 13, ll. 23 to pg. 14, ll. 1-3). The embodiments are therefore related to a personalized modem capable of storing identifying indicia unique to the modem. (Spec. pg. 3, ll. 1-2).

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A method of communicating via modem 40 is also shown and described in reference to Fig. 3 and pg. 14, ll. 7-13, which generally includes communicating the identifying indicia to a transaction server 52 as needed to authenticate or validate a transaction. These specific embodiments are provided by way of example and those of ordinary skill in the art will appreciate that modification, variations and extensions of the particular embodiments are possible without varying from the fundamental teachings of the present invention. (Spec. pg. 14, ll. 15-19).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The only issue for consideration on this Appeal is:

A. Whether claims 1-21 were properly rejected under the written description requirement of 35 U.S.C. § 112 first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed subject matter.

VII. ARGUMENT

A. APPELLANT'S CLAIMS ARE FULLY SUPPORTED BY THE APPLICATION AS FILED.

LEGAL STANDARD

It is well established that the objective standard for determining compliance with the written description requirement is "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989).

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In determining whether the description requirement is met, the examiner has the initial

PAGE 8/15 * RCVD AT 11/28/2005 4:43:25 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/31 * DNIS:2738300 * CSID: * DURATION (mm-ss):04-12, organize in

APPELLANT'S BRIEF
U.S. Appln. No. 09/385,607

Appellant's specification generally discloses that a compressed image could be used for authentication purposes of the inventive embodiments (Spec. pg. 7, ll. 13-14) and that identifying indicia may be personalized to the user (Spec. pg. 3, ll. 1-2). Further, Appellant expressly describes an example identifying indicia to include an image of a credit card complete with signature and preferably the image of the account holder (Spec. pg. 13, ll. 23 to pg. 14, ll. 2). Appellant respectfully submits that simply because the disclosure discusses a preferred embodiment where various image information is be used for authentication purposes as a combination, it does not mean the skilled artisan would not recognize each could alternatively be used individually, particularly where each type of information that could be used is explicitly disclosed.

While admittedly, Appellant does not expressly describe all potential combinations or every individual type of graphics information that could possibly be used for authentication, Appellant believes the skilled artisan would clearly recognize from the disclosure that Appellant invented what is claimed, thus it is believed the objective test regarding compliance with the written description requirement is fully satisfied. Further, since there has been no attempt to explain why the skilled artisan would not recognize various images could be used other than in combination, particularly in light of the specification explicitly disclosing that variations and modifications to the specific embodiments are possible (Spec. pg. 14, ll. 15-19), Appellant believes the rejection under 35 U.S.C. § 112, first paragraph, is improper and should be overturned.

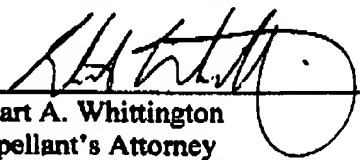
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Appellant lastly points out that, while not necessarily pertinent to the Board's decision, the limitations in question were individually presented by claim amendments (e.g., new claims 22-27) on December 13, 2003. The new claims were not only entered into the record by the previous examiner (having signature authority) without objection, but were also indicated as including allowable subject matter. (See Appellant's amendment of December 17, 2003 and subsequent Office Action dated March 12, 2004). Appellant subsequently amended the claims of this application based on the previous examination record only to now find these claim limitations do not meet the written description requirement. Respectfully, Appellant believes it should be entitled to a reasonable degree of consistency in examination of the same application or, if the rejection is sustained, be entitled to a refund of all fees paid in the course of relying on the necessarily flawed examination record of a previous examiner.

VIII. CONCLUSION.

It is respectfully submitted that in view of the foregoing all of the pending claims are patentable and the Board is respectfully requested to overturn the rejection of record and allow this application to issue.

Respectfully submitted,



Stuart A. Whittington
Appellant's Attorney
Registration No. 45,215
Intel Corporation

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U.S. Appln. No. 09/385,607

(480) 715-3895

c/o
Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA. 90025-1026
(503) 264-0967

Date: November 28, 2005

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APPENDIX A
(Claims on Appeal)

1. (Previously presented) A secure communications method, comprising:
providing a modem capable of storing identifying indicia unique to the modem,
wherein the identifying indicia includes graphics data, the graphics data comprising an
image of at least one of a credit card, a signature, or an account holder; and
providing communications software stored within the modem, capable of
transmitting identifying indicia to a communications line.
2. (Original) The secure communications method of claim 1, wherein the modem
stores the identifying indicia integral to the modem.
3. (Original) The secure communications method of claim 2, wherein the
identifying indicia comprises bits accessible by processing circuitry of the modem in a
read operation, the process circuitry reading the bits prior to causing the bits to be
transmitted over the communications line..
4. (Original) The secure communications method of claim 3, wherein the bits are
stored within a memory array.
5. (Original) The secure communications method of claim 1, comprising a
process for permanently fixing the identifying indicia in circuitry of the modem.
6. (Original) The secure communications method of claim 5, wherein the process
for permanently fixing comprises blowing fuses.
7. (Original) The secure communication method of claim 5, further comprising
encrypting the identifying indicia prior to causing the identifying indicia to be transmitted
over the communications line.

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APPENDIX A
(Claims on Appeal)

8. (Original) The secure communications method of claim 1, wherein the identifying indicia are stored in the modem within a memory associated with a program memory of the modem.

9. (Previously presented) The secure communications method of claim 8, wherein the identifying indicia are writable only when the program memory is overwritten.

10. (Original) The secure communications method of claim 9, wherein the identifying indicia are formatted as compressed graphics data.

11. (Previously presented) A secure communications modem, comprising:
a program memory adapted to store a program controlling aspects of modem operation; and

a processor, coupled to the program memory, the processor executing at least a portion of a program stored in the program memory to control at least an aspect of modem operation,

the program adapted to cause the processor, under control of the program, to read identifying indicia stored integrally within the modem and communicate the identifying indicia to a host communicating with the modem, wherein the identifying indicia includes graphics data, the graphics data comprising an image of at least one of a credit card, a signature, or an account holder.

12. (Original) The modem of claim 11, wherein the identifying indicia are stored in an indicia memory physically or logically adjacent the program memory.

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APPENDIX A
(Claims on Appeal)

13. (Previously presented) The modem of claim 11, wherein the identifying indicia are stored in an indicia memory, the indicia memory writable only when program memory is written.

14. (Original) The modem of claim 11, wherein the identifying indicia are stored permanently within the modem.

15. (Original) The modem of claim 11, further comprising means for encrypting the identifying information prior to communicating the identifying information to the host.

16. (Original) The modem of claim 14, further comprising means for encrypting the identifying information prior to communicating the identifying information to the host.

17. (Original) The modem of claim 15 wherein the identifying indicia are stored within a write once memory array and are accessible in a register read operation by the processor.

18. (Original) The modem of claim 14, wherein the identifying indicia identify an aspect of a financial transaction account.

19. (Original) The modem of claim 11, wherein the identifying indicia include an account number for a financial transaction account.

20. (Original) The modem of claim 11, wherein the identifying indicia are stored in nonvolatile memory within the modem.

APPELLANT'S BRIEF
U.S. Appl. No. 09/385,607

APPENDIX A
(Claims on Appeal)

21. (Original) The modem of claim 20, wherein the identifying indicia are stored in a compressed format.

Claims 22-27. (Cancelled)